

Application Serial No. 09/882,409
Reply to Office Action of July 18, 2008

PATENT
Docket: CU-5986

REMARKS

In the Office Action, dated July 18, 2008, the Examiner states that Claims 217-229 and 231-246 are pending and rejected. By the present Amendment, Applicant amends the claims.

Double Patenting

The Office Action asserts that should Claim 226 be found allowable, Claim 227 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Moreover, the Office Action asserts that should Claim 241 be found allowable, Claim 242 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Applicant has amended Claims 227 and 241 to differentiate them from Claims 226 and 242, respectively. As such, Applicant respectfully asserts that should Claims 226 and 241 be found allowable, Claims 227 and 242 should not be objected to under 37 CFR 1.75.

Claim Rejections Under 35 U.S.C. 112, second paragraph

Claims 232, 233 and 235 are rejected under 35 U.S.C. 112, second paragraph, as being allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Office Action considers that Claims 232 and 233 each recite the feature of "the repellency of the unexposed areas" but there is not proper antecedent basis for this feature. Claims 232 and 233 formerly recited the feature of "the repellency of unexposed areas" but are currently amended to recite the feature of "repellency of unexposed areas."

Moreover, the Office Action considers that there is insufficient antecedent basis for the term "the ink-jet system" in Claim 235. Applicant has amended the term "the ink-jet system" to read "an ink-jet system."

In view of the foregoing amendments, Applicant respectfully requests withdrawal of the rejection of Claims 232, 233 and 235 under 35 U.S.C. 112, second paragraph.

Rejection Under 35 U.S.C. 102(b)

Claims 217-229, 231-233, 236-242, 245 and 246 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1 329 589 for the reasons of record. Applicant respectfully disagrees with and traverses this rejection.

In view of the currently amended claims, Applicant respectfully asserts that

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the "material of which the wettability is variable through photocatalytic action upon pattern-wise exposure" is amended to read "silicone, in which groups containing a fluoroalkyl group are bonded to silicon atoms." In this respect, the silane compound taught in GB 1 329 589 is disclosed as merely including polydimethyl silane. No other silane compounds are taught or suggested in this reference.

Since GB 1 329 589 does not teach or suggest each and every feature of the currently amended claims, such as "silicone, in which groups containing a fluoroalkyl group are bonded to silicon atoms," Applicant respectfully asserts that this reference does not anticipate the present set of claims. As such, Applicant respectfully requests withdrawal of the rejection of Claims 217-229, 231-233, 236-242, 245 and 246 under 35 U.S.C. 102(b).

Rejection Under 35 U.S.C. 103(a)

Claims 217-229 and 231-246 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1 329 589 for the reasons of record. Applicant respectfully disagrees with and traverses this rejection.

As stated above, the silane compound taught in GB 1 329 589 is disclosed as merely including polydimethyl silane. No other silane compounds are taught or suggested in this reference.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

Since GB 1 329 589 does not teach or suggest each and every feature of the currently amended claims, such as "silicone, in which groups containing a fluoroalkyl group are bonded to silicon atoms," Applicant respectfully asserts that the currently amended claims cannot be deemed obvious over this reference. As such, Applicant respectfully requests withdrawal of the rejection of Claims 217-229 and 231-246 under 35 U.S.C. 103(a).

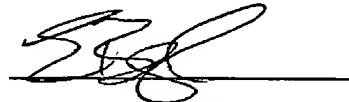
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In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

January 7, 2009
Date



Attorney for Applicant
Eric D. Babych
c/o Ladas & Parry LLP
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300
Reg. No. 57,542